

REMARKS

Phone conversation with Supervisor Etienne

On 9/1/04, undersigned agent Dr. Ron Jacobs had a phone conversation with Supervisor Ario Etienne. Jacobs raised several concerns: (i) two premature finalities, (ii) Breese as a reference in view of the claimed invention, (iii) inconsistencies in the latest Office Action, and (iv) incompleteness of the latest Office Action to argue obviousness.

Supervisor Etienne indicated to proceed with the filing of the response to the latest office action. Supervisor Etienne also indicated that he would be directly involved and working with Examiner Burgess in reviewing the case.

CLAIM REJECTION, 35 USC Paragraph 103

Claims 1-62 were rejected under U.S.C. 103(a) as being unpatentable over *Breese et al.* (U.S. Patent No. 6,006,218).

In reply, the Applicants respectfully disagree.

1. Incomplete and inconsistent office action

In the Office Action dated January 29, 2004 the Examiner rejected claims 1-62 under U.S.C. 103(a) as being unpatentable over *Breese et al.* (U.S. Patent No. 6,006,218) in view of *Hertz et al.* (U.S. Patent No. 5,754,939).

As stated in the January 04 Office Action, the Examiner believed that *Breese* disclosed claim element 1a, 1b, and 1d and believed that *Hertz* disclosed claim element 1c, 1e and 1f. The Examiner further believed that the combination of *Breese* and *Hertz* rendered the claims obvious. In the latest Office Action, the Examiner dropped *Hertz* in the 103 argument pursuant of Applicants' previous arguments and still alleges that "*Breese does not explicitly disclose*" 1c, 1e and 1f [page 3 of the Office Action; underline and italic by Applicants]. If *Breese* does not explicitly disclose as the Examiner states, how can a complete and lawful 103 argument be construed that render the claims obvious?

Accordingly, the Office Action is incomplete and inconsistent with respect to lawful 103 arguments and therefore the finality of the Office Action is premature. The Applicants respectfully request that the finality of the latest Office Action be withdrawn *or* that all claims be allowed.

2. Breese does not teach not suggest the claimed invention

- A. The teachings of *Breese* as a whole don't suggest to a person of ordinary skill in the art the combined claims elements of the independent claims presented in the original application (see below).
- B. The teachings of *Breese* don't provide a reasonable expectation of success simply because *Breese* cannot predict beyond its memory model (see below)!
- C. *Breese* would destroy the intended function of the present invention. *Breese* tallies up seen objects, determines the probability that a user has seen the object,

and then does not show it again to the user. The present claimed invention application is very different from *Breese's* concept (see below).

D. *Breese* does not teach and not even address the problem of generality and predictability beyond a memory model and can therefore not render the present claims obvious (see below).

The Applicants also submit herewith the following arguments indicating that *Breese* is not teaching nor suggesting the claims in the present application. The Applicants hereby also incorporate all previous arguments made in previous replies to Office Actions.

The present invention is a method for predicting user interests in documents and products using a learning machine and probability measures.

Breese is a memory model (See abstract) and teaches that one could determine the probability that a user knows about an item – i.e. the user has seen that item in the past. Note knowledge probability (i.e. memory) as in *Breese* IS NOT the same as probability that documents are of interest (i.e. generalization/estimate probability) as in the present application as an artisan would readily appreciate.

For example **could *Breese* use a user-model for apples to predict if the user is interested in pears?** The answer is NO, since *Breese's* user-model for apples has **no knowledge or generalization power** related to pears. The teachings in *Breese* are knowledge-based without any teachings on how to use that knowledge (memory) model to generalize

beyond that or become application independent – independent from apples and extend to pears or even potatoes. It is one of the objectives of the present invention as claimed to overcome these shortcoming; i.e. a learning machine in the probability domain and cross-fertilization of learning in one mode to another mode.

Generalization predicts beyond items in the past and even beyond the user itself; it estimates probability of something to happen in the future. It is exactly this generalization that is claimed in claims 1 and 32 by:

- (1) using the monitored actions to estimate parameters of a learning machine, and
- (2) using the learning machine to estimate the probability that a document is of interest to a user.

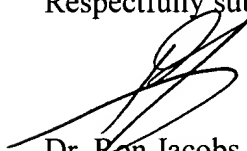
Accordingly, the Applicants submit that the present claims 1-62 are NOT obvious with respect to *Breese*. A prima facie case of obviousness (See MPEP 2143) has not been established as discussed *supra*.

CONCLUSION

Applicants respectfully submit that the present claims 1-62 are **NOT obvious** with respect to *Breese*. A **prima facie** case of obviousness (MPEP 2143) has **not been established** as discussed *supra*. In addition the finality of the Office Action is premature due to an incomplete and/or inconsistent Office Action.

Therefore, the Applicants submit that claims 1-62 are novel and unobvious over the closest prior art of record. Accordingly, allowance of the claims now in the application is kindly requested.

Respectfully submitted,



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